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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,974	01/22/2004	Hassan Pajouhesh	381092001600	7894
25225 7590 05/29/2008 MORRISON & FOERSTER LLP 12531 HIGH BLUFF DRIVE SUITE 100 SAN DIEGO, CA 92130-2040				
EXAMINER				
KOSACK, JOSEPH R				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
05/29/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/763,974

Applicant(s)

PAJOUHESH ET AL.

Examiner

Joseph R. Kosack

Art Unit

1626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

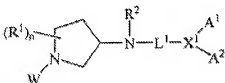
Claims 1-23 are pending in the instant application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 26, 2008 has been entered.

Scope of Elected Subject Matter

The scope of elected subject matter has been expanded from the group pursuant to the provisions of MPEP 803.02 and the unity of invention test set out by the CCPA in 1980 (*In re Harnisch*, 631 F.2d 716, 206 USPQ 300) the scope of the search has been limited to the following substituents of the base structure of Formula I:



where:

- W is L²-A³;
- all other substituents are as defined.

The non-searched subject matter does not have unity of invention with the searched subject matter. While the entire genus as claimed is claimed to have the same utility, the W group is deemed to be substantial structural features essential to the utility

of the invention as it is part of the core structure of the molecule and can either have one or two ring structures attached to it. Ring structures that are within the core structure of a molecule are extremely important as they control the size of the molecule in order to fit and interact with the desired receptor site or protein. Therefore, the molecules in which W is not L2-A3 have not and will not be examined in the instant application. It is suggested that Applicant cancel this subject matter from the claims and pursue the subject matter in a divisional application.

Previous Claim Objections

Claims 1-17 and 21-23 were objected to in the previous actions for containing elected and non-elected subject matter. The non-elected subject matter has not been cancelled yet from claims 1-12, 15-17, and 21-23, therefore the objection stands for those claims. Claims 13-14 have been searched in their entirety, and the objection is withdrawn for those claims.

Previous Claim Rejections - 35 USC § 103

Claims 1-14, 16 and 23 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroita et al. (USPN 6,468,998).

Applicant's amendments have removed the unpatentable subject matter, and the rejection is withdrawn.

Claim Objections

Claims 1-12, 15-17, and 21-23 are objected to for containing elected and non-elected subject matter. The elected subject matter has been identified supra.

Claim Rejections - 35 USC § 112

Art Unit: 1626

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14, 16, and 21-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant claims:

each of L^1 and L^2 is a C_1 - C_{10} optionally substituted alkylene or C_2 - C_{10} optionally substituted alkenylene, wherein one or more said C is optionally replaced by a heteroatom selected from N, O or S, or further substituted with =O, or both;

The instant specification discloses compounds that have either an alkylene linker substituted with (O) or a linker for L^1 that is $-C(O)NH-$. Meanwhile, the claim is defined to include many other functionalities, alone or mixed together, with no guidance as to how those would come about. Hence, the specification does not teach a representative number of examples to cover the genus as claimed. Therefore, the definitions for L^1 and L^2 are not described adequately in the specification and the claims do not meet the written description provision of 35 U.S.C. 112, first paragraph.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 and 21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the instant case, formula I contains a

Art Unit: 1626

variable "n" which is not defined in the claims. Appropriate correction that does not introduce new matter is required.

Claim Rejections - 35 USC § 102

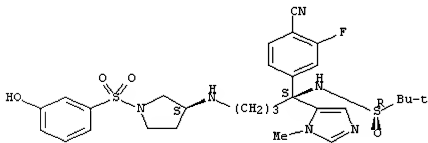
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Desolms et al. (WO 2002/20015 A1).

Desolms et al. teach the compound



which reads on the

claims where L1 is a C₃ alkylene linker, W is L²-A³, L² is a C₁ alkylene linker where the C is replaced by an optionally substituted S, X¹ is CR³, R³ is a C₅ alkyl having one C replaced by S, R² is H, n is 0, and A¹, A², and A³ are aromatic rings. See page 89, Step J, lines 16-30.

Conclusion

Claims 1-17 and 21-23 are rejected. Claims 1-12, 15-17, and 21-23 are objected to.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Kosack whose telephone number is (571)272-5575. The examiner can normally be reached on M-Th 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rebecca L Anderson/
Primary Examiner, Art Unit 1626

/Joseph R Kosack/
Examiner, Art Unit 1626